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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,125	03/26/2001	Masahiro Minowa	81747.0191	8629
26021	7590	03/22/2005	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,125

Applicant(s)

MINOWA, MASAHIRO

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed December 21, 2004. Applicant amended claims 1, 16 and 23.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 16-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Yanagisawa et al., EP 1 035,527 A2.

Regarding claims 16-22, Yanagisawa teaches sending the application page containing an advertising placement page, receiving and storing input information containing advertising, calculating an advertisement fee, sending a payment specification form containing the calculated fee, with a first server (see col. 6 line 49 to col. 7 line 21, (server 121), confirming fee payment,

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with a second server, registering in the POS system advertising information for which payment has been confirmed with a central computer (see col. 12 line 20 to col. 13 line 9, (cash register 131, including CPU 132). Yanagisawa teaches the cash register (computer) providing means for conforming fee payment and means for registering the advertisement information for which payment has been confirmed with a central computer. Yanagisawa teaches outputting advertisement etc. (see col. 3 lines 10-47, col. 5 lines 4-45, col. 14 line 1 to col. 15 line 8 and fig. 1-16). Yanagisawa teaches confirming credit card validity, sending specific information in the input information to the POS system specified by the input information, confirming and sending specific information in the input information to the confirmed POS system, distributing advertising information by a central computer connected to a plurality of POS system (see 3 lines 33-42, col. 6 line 46 to col. 7 line 21, col. 11 lines 2-47, col. 12 line 47 to col. 14 line 27).

Regarding claim 23, Yanagisawa teaches a first server providing means for storing an application page containing an advertising placement application form; an application management unit for sending the application page to client PC, storing input information containing advertising placement information (see col. 6 line 49 to col. 7 line 21, (server 121), central computer providing unit for distributing specific data in the input information specified by the client PC to a POS terminal (see col. 7 lines 23 to col. 8 line 12 (cash register 131, including CPU 132), wherein the POS terminal device prints the advertising placement information (see col. 13 line 49 to col. 14 line 34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa et al., EP 1 035,527 A2 and further in view of Marshall et al. U.S. Patent No. 6,650,429.

Regarding claims 1, 3-6, 14 and 15, Yanagisawa teaches a first server providing means for storing an application page, for sending the application page, for receiving and storing input information containing advertising placement information (see col. 3 lines 28-47, col. 6 line 49 to col. 7 line 21, (server 121), means for distributing specific data and for controlling printing the advertising (see col. 7 lines 23 to col. 8 line 12 (cash register 131, including CPU 132).

Yanagisawa teaches the server 121, connected to a computer (central computer), providing means for exchanging information with a headquarter and for the headquarter to send advertisements other than those to be input by advertisers at the terminal (see col. 7 lines 5-21).

Yanagisawa teaches the register including a CPU, which provides means for controlling the printing (see abstract, col. 13 line 49 to col. 14 line 16). Yanagisawa failed to teach central computer providing means for distributing specific data in the input information to POS system in a specific area specified by the PC, it is taught in Marshall. Marshall teaches client specifying distribution of the message to specific area, such as stores of chain store, (see col. 8 lines 1-29) a central computer (database manager 40, including the publisher module) providing means for distributing the specific data to printers specified by clients (see col. 7 lines 1-43, col. 13 line 39

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to col. 14 line 42, col. 16 lines 11-65). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to modify Yanagisawa's advertisement distribution method with Marshall's selectively printing means by providing means of distributing the message to specified area specified by the client. One would be motivated to specify specific area to distribute the advertisement, in order to specifically target a group or groups of individuals or stores, as taught in Marshall (see col. 8 lines 30-67).

Regarding claim 2, Yanagisawa teaches means for calculating an advertising placement fee, means for storing and sending the calculated fee information to the client PC, means for confirming fee payment, ... (see col. 3 lines 10-47, col. 5 lines 4-45, col. 14 line 1 to col. 15 line 8 and fig. 1-16).

Regarding claims 7-11, Yanagisawa teaches application page enabling specification of one or more conditions restricting advertising placement, advertising period, number of pages printed for advertising, time period, target for whom the advertisement information is presented (see fig. 6-16, and col. 9 line 22 to col. 14 line 55).

Regarding claims 12 and 13, Yanagisawa teaches POS system including a POS terminal with a printer for printing receipts and advertising information, including a customer display device (see fig. 4 and col. 13 line 49 to col. 14 line 16).

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta
Primary Examiner
Art Unit 3622

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